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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------|------------------|
| 10/010,731 | 11/13/2001 | Jihong Liang | MOBT:193--2 | 4312 |
| 7590 | 05/18/2004 | | EXAMINER | |
| Elizabeth Graf HOWREY SIMON ARNOLD & WHITE, LLP 750 Bering Drive Houston, TX 77057-2198 | | | IBRAHIM, MEDINA AHMED | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1638 | |
| DATE MAILED: 05/18/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/010,731 | LIANG ET AL. |
| | Examiner | Art Unit |
| | Medina A Ibrahim | 1638 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 09 March 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 15-17,25,26,28,29,33 and 34 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) 15-17 and 33 is/are allowed.

6) Claim(s) 25,26,28,29 and 34 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

 a) All b) Some * c) None of:

 1. Certified copies of the priority documents have been received.

 2. Certified copies of the priority documents have been received in Application No. _____.

 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

 * See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

 a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

4) Interview Summary (PTO-413) Paper No(s) _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicant's response filed 03/11/04 in reply to the Office action of 07/01/03 has been entered. Claims 1-14, 18-24 and 31-32 have been cancelled. Claims 15-17, 25, 28-29, and 33-34 have been amended. Therefore, claims 15-17, 25-26, 28-29 and 33-34 are pending and are examined.

All previous objections and rejections not set forth below have been withdrawn in view of Applicant's amendment to the claims.

Claim Objections

Claim 26 does not further limit claim 25.

New Matter

Claims 25-26 and 28-29 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a NEW MATTER rejection.

The claims recite a transgenic plant having incorporated into its genome a nucleotide sequence as set forth in SEQ ID NO: 10 from position 92 through position 307. However, support for the phrase "SEQ ID NO: 10 from position 92 through position 307" cannot be found in the specification or in the claims as originally filed. The nucleotide sequence of Figure 1 is insufficient to provide support for the phrase.

Therefore, the phrase "SEQ ID NO: 10 from position 92 through position 307" is considered to be a new matter. Applicant is requested to point to support for the phrase in the original specification or to delete the NEW MATTER in response to this rejection.

Claim Rejections - 35 USC § 112

Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

At claim 34, a " plant cell being a member" is awkward. It is suggested that " member" be replaced with ---plant--.

Remarks

Claims 15-17, 25-26, 28-29 and 33-34 are free of the prior art because the prior art does not teach or reasonably suggest a recombinant host cell comprising a nucleotide sequence encoding SEQ ID NO: 2 or 14, and transgenic plant comprising the nucleotide sequence from position 92 to position 307 of SEQ ID NO: 10, or from position 18 to position 507 of SEQ ID NO: 10, or from position 105 to 242 of SEQ ID NO: 13 or a nucleotide sequence that encodes SEQ ID NO: 2 or 14; nor that the prior art teaches a method that employs said nucleotide sequences.

Claim 34 would be allowable if the 112, 2nd rejection is obviated.

Claims 15-17 and 33 are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Medina A. Ibrahim whose telephone number is (571) 272-0797. The Examiner can normally be reached Monday -Thursday from 8:00AM to 5:30PM and every other Friday from 9:00AM to 5:00 PM . Before and After final responses should be directed to fax nos. (703) 872-9306 and (703) 872-9307, respectively.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. Amy Nelson, can be reached at (571) 272-0804.

5/12/04
Mai



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SUPERVISORY PATENT EXAMINER
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